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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,033	02/04/2004	Jed E. Rose	014622.000001	2032

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EXAMINER

LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/708,033

**Applicant(s)**

ROSE ET AL.

ed

**Examiner**

Benjamin H. Layno

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's arguments filed 12/22/05 have been fully considered but they are not persuasive. The Examiner is maintaining the § 102 and §103 rejection in the first Office action, however, the Examiner is adding a § 101 non-statutory subject matter rejection, see below.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention, recited in claims 1-11, is directed to the mere arrangement of printed matter on playing cards. A mere arrangement of printed matter, though seemingly a "manufacture" is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter sets forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to substrate they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to

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the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself is non-statutory subject matter. See *In re Sterling*, 70 F.(2d) 910, 21 C.C.P.A 1134, *In re Russell*, 48 F.(2d) 668, 18 C.C.P.A. 1184, and *In re Reeves*, 62 F.(2d) 199, 20 C.C.P.A. 767.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dwyer. The Applicant is referred to the teaching of Dwyer in the first Office action.

The Applicant has argued that *Ex parte Breslow* related to a claimed combination card game/board game, where the prior art Mitchell patent also involved a combination card game/board game. The function between the cards and the board in the Mitchell game was the same as the function between the cards and the board in appellant's claimed game. In contrast, applicants' playing cards have significant structural differences in that the cards have two different suits, where the first suit has the structure of threat cards and the second suit has the structure of tool cards. However in Dwyer, there are two suits, but the cards of the first suit are the same as the cards of the second suit, with only a minor variance in border color. Thus, the function between applicants' first suit and second suit is different from the function between Dwyer's first suit and second suit. The function of the Applicant's claimed two suits is to tell a story, while the function of Dwyer's two suits is to teach children the alphabet.

The Examiner takes the position that the Applicant's arguments are based on how the printed matter on the two suits is used to play a game. This relates to game rules or method of play. Whereas, claims 1-11 are directed to playing cards or apparatus. In apparatus claims only the physical structure is given weight. The physical structure of Dwyer's two suits having a variance in color design, and the physical structure of the Applicant's claimed two suits having legends relating to threat cards and tool card, both perform the same function. In both cases the physical structure is printed matter, and the function of the printed matter is to distinguish the two suits. Thus, the only difference between Dwyer's variance in color design to distinguish Dwyer's two suits, and the Applicant's claimed legends relating to threat cards and tool cards to distinguish the claimed two suits, resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431. Note, *Ex parte Breslow* is based on a 102(b) rejection.

Applicants respectfully point out that the Examiner's conclusion [cards provide a substrate or support for the legends and the pictures such that the legends and pictures can be displayed for convenience of the players] is true of all card games, and if that were a reason for lack of patentability, then no card game would ever be patentable. The Examiner takes the position that the Applicant's arguments are again based on card games or method of playing card games. Many card games are patentable. Most of the recently patentable card games are directed to the **method** of playing a card game. However, it is more difficult to receive a patent for playing cards **apparatus**.

The Applicant continues to argue that the Examiner's reason for lack of patentability is erroneous, as the Examiner has misinterpreted the meaning of *In re Gulack*. Rather, *In re Gulack* stands for the proposition that differences between the claimed invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter. Applicants respectfully submit that the Examiner is ignoring the differences between Applicants' claimed invention and the card game of cited Dwyer merely because those differences resides in the content of printed matter.

In the case of *In re Gulack*, 217 USPQ401, *Gulack's* invention comprised a circular band (substrate) and a sequence of numbers derived from a mathematical algorithm (printed matter) printed on the band. The patent to Wittcoff, which was used by the Examiner to reject *Gulack's* claims, comprised a circular band (substrate) and informational data such as addition, subtraction, historical dates, etc. (printed matter) printed on the band. The "critical question" raised in *Gulack* was "whether there exists any new and unobvious functional relationship between the printed matter and the substrate". The Court determined that Wittcoff simply exploited the band as a means of supporting and displaying informational data in an endless loop configuration, wherein the data was not arranged in any particular sequence. On the other hand, the Court found that *Gulack's* particular sequence of digits, which has a "cyclic nature", and the positioning of this sequence of digits on the band exploited the endless nature of the band. This exploitation provided a new and unobvious functional relationship between the printed matter and the substrate.

The Examiner takes the position that the Applicants' playing cards (substrate) functionally relate to the Applicants' legends relating to threat and tool (printed matter) as a means of conveniently supporting and displaying the Applicants' legends relating to threat and tool (printed matter). This functional relationship is clearly taught by Dwyer above. There is no unobvious functional relationship between the Applicants' playing cards (substrate) and legends related to threat and tool (printed matter) that uniquely exploits the nature of the Applicants' playing cards.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Bouchal 799'.

The Applicant is referred to the first Office action.

The Applicant has argued the Calhoun reference individually by stating that Calhoun requires that the sentence on the sentence card and the picture on the picture card are already predetermined to inherently relate to each other. The Examiner cited Calhoun because it teaches several of the steps recited in the claims, not whether the sentence cards and picture cards are predetermined to inherently relate to each other. This is beside the point. Note, there is no recitation in claims 12-27 that limit the threat cards and tool cards to be inherently related or unrelated in any way.

Furthermore, the Applicant has also argued the Bouchal 799' reference individually by stating that Bouchal '799 requires that the player arranges a plurality of picture cards in a matrix array that is a logical sequence so that the player can tell a story based on what the arrangement means. In the Applicant's method, there is no arranging of a plurality of picture cards into a matrix. The Examiner cited Bouchel 799' because it teaches that it is known in card games for players to observe the legends and pictures on displayed cards, and use the legends and pictures to tell a story.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

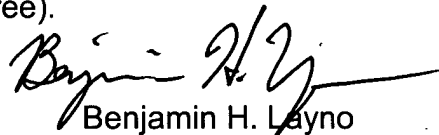
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
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bhl